

Application No.: 10/695,657
Amendment dated: January 17, 2006
Reply to Office Action of October 17, 2005
Attorney Docket No.: 21295.0069US1 (H5747US)

b.) Remarks

Claims 1-12 are pending in this application. Claims 1-12 are rejected. Claim 1 has been amended in various particulars as indicated hereinabove. Claims 8 and 9 have been cancelled, because the elements of these Claims have been incorporated into amended independent Claim 1.

Turning now to the merits, Claim 1 was rejected under 35 U.S.C. 103(a) over Ursinus (US Patent No. 2040066), in view of Mori (US Patent No. 3734593), Zeiss (DE 9413513U1), and Scouten et al. (US Patent Application Publication 2003/0120282A1). This rejection is respectfully traversed for the following reasons.

For an obviousness rejection to be proper, the Patent Office must meet the burden of establishing a prima facie case of obviousness. The Patent Office must meet the burden of establishing that all elements of the invention are disclosed in the cited publications, which must have a suggestion, teaching or motivation for one of ordinary skill in the art to modify a reference or combined references.¹ The cited publications should explicitly provide a reasonable expectation of success, determined from the position of one of ordinary skill in the art at the time the invention was made.²

Applicants have reviewed the publications cited in the Office Action. The Patent Office asserted that Ursinus discloses "an illumination system including at least one light source for specimens placed on the stage (See for example e, e' in Figure 11); and an attachment device for the illumination system is connected to each macroscope (See for example attachment of e, e' onto b, b' in Figure 11)". Turning to Ursinus, Col 1, lines 37-38, discloses that "electric lamps e, e' enclosed in shades for illuminating the surfaces of the objects concerned." E and e' in Ursinus disclose an illumination system in the form of a simple electrical lamp, the same e and e' in Fig. 11 of Ursinus do not disclose anything else. Those references e and e' in Fig. 11 do not disclose any attachment device either, simply because they are only two electrical lamps enclosed in shades. Nor do they

¹ *In re Sang Su Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

² *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970);

Amgen v. Chugai Pharmaceuticals Co., 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996);

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disclose an attachment device for the illuminating system with a plurality of moveable arms. Therefore, it is incorrect to assert that the separate illumination system and attachment device as claimed in Claim 1 are disclosed in Ursinus.

Also, the Patent Office has stated that Zeiss teaches a microscope optical system which utilizes an illuminator attachment means that includes a plurality of moveable arms and an adjustable holder for the light source. According to the Office Action, if Zeiss is combined with the visual scales and indicia of Scouten, the attachment device with a plurality of moveable arms with at least one scale disposed on each moveable arm could have been obvious to one of ordinary skill in the relevant art. Applicants assert that Scouten is non-analogous art that should not have been combined with Zeiss in the first place.

To determine whether a publication is analogous, two criteria are used: 1) whether the art is from the same field of endeavor, and 2) if the publication is not from the same field of endeavor, whether it is still reasonably pertinent to the particular problems with which the inventor is involved. If a cited publication is directed to a different purpose, the inventor, accordingly, have had less motivation or occasion to consider it.³

In view of this standard, Scouten is a non-analogous publication. It deals with a low-cost system for digitally displaying locations of stereotaxic manipulators during a stereotaxis procedure on rats or mice (Abstract). Such stereotaxic manipulators are used when an invasive neurological procedure is performed on a rat or mouse, so it must be held in a secure and stationary position throughout the duration of a surgical or other procedure (paragraph [0002]). In particular, the mammal's head has to be immobilized, and a manipulator assembly is used to control the movements of needles, blades, electrode tips, patch clamps and other instruments used for an invasive procedure on an anatomical structure of the mammal (Paragraphs [0006] and [0009]).

The present invention as claimed in Claim 1 has nothing to do with a manipulator assembly for moving needles and blades during an operation on rats or mice. The

³ *In re Clay*, 966 F.2d 656, 23 USPQ2d 1058, (Fed. Cir. 1992), see also *Heidelberger DruckmaschinenAG v. Hantscho Comm. Prods., Inc.*, 21 F.3d 1068, 30 USPQ2d 1377 (Fed. Cir. 1994).

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Scouten field of endeavor is very different from a forensic comparison microscope of the present invention. Also, the problem of controlling surgical instruments while operating on an immobilized mammal is not reasonably pertinent to the problem of reproducibility of the measurement conditions in a forensic comparison optical system which uses scales on the arms of an illumination system to set identical illuminating conditions on both stages and to provide reproducible illumination conditions for the later repeated similar comparison measurements.

Moreover, with regard to the motivation requirement of the non-obviousness test in general, and the non-analogous test in particular, it is impossible to see how a person of ordinary skill in the art could have had any motivation to combine Zeiss with Scouten, because the Scouten publication of June 23, 2003 happened months after the priority filing date of October 31, 2002, of the present application. Applicants assert that no person can be motivated to combine Zeiss with anything that was not published and not available to Applicant before the filing date of the present application.

Therefore, at least for the above-articulated reasons, Scouten cannot be combined with Zeiss or with any other publications cited in the Office Action to defeat the non-obviousness of Claim 1.

Since independent Claim 1 was amended and now incorporates the elements of Claim 9 together with the intervening Claim 8, Applicants turn to page 7 of the Office Action and the reasons for rejection of Claim 9. Claim 9 was rejected under 35 U.S.C. 103(a) as over Ursinus in view of Mori, Zeiss, and Scouten et al., as applied to Claims 1, 8 above, and further in view of Bacus et al (US 6,101,265). This rejection is respectfully traversed for the following reasons.

The Patent Office has stated that Bacus "additionally discloses that various positional values for the various encoders, illumination conditions, as well as various image data may be saved to and retrieved from filed in the memory on the computer." Applicants respectfully point out that Bacus does not disclose what is claimed in amended Claim 1. In particular, Bacus discloses analyzing a histological specimens in a pathology setting, in which, in order to perform a magnification of a certain area of

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interest, "the overall illumination and control of the microscope will be controlled so that in a step 210 the objective turret 142 will be rotated to place of higher power objective above the slide 18." (Col. 9, lines 15-19). When a selected region is identified, the computer mouse is moved there and the region is selected. The X and Y screen points for the edges of the selected regions are computed. The information from the X offsets for the objective and the stage is used to position the slide (with the specimen) under the objective to capture the micro image. (Col. 9, lines 36-49).

In comparison, Claim 1 is directed to establishing optimal illumination conditions for two microscopes and two XYZ stages with samples on each stage, the optimal illumination values are determined based on the values of at least one scale disposed on each moveable arm of the attachment device, wherein these stored values (such as readings on the scales) are stored together with the images of the compared objects and are retrieved together with the image data for any later investigation (where the same illumination conditions need to be reproduced). The Bacus patent does not disclose the same elements as amended Claim 1 and the apparatus in Bacus does not function the same way.

Therefore, for all the reasons presented above, amended independent Claim 1 is not obvious over the publications cited by the Patent Office. Applicants request that the 103(a) rejection be withdrawn and Claim 1 be allowed. Claims 2-7, and 10-12 depend off now allowable Claim 1 and are allowable.

Applicants believe that the present application is in condition for allowance. Should any questions arise, the Examiner is encouraged to contact the undersigned.

Respectfully submitted,

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